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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,441	08/31/2001	Stephan Brunner	05306.P028	3599
7590 12/29/2005			EXAMINER	
Andre M. Gibbs Blakely, Sokoloff, Taylor & Zafman LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1030			HAQ, NAEEM U	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 12/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/945,441	BRUNNER ET AL.	
Examiner	Art Unit	
Naeem Haq	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment filed on October 6, 2005.

Claims 1-39 are pending and will be considered for examination.

Applicants' amendments are sufficient to overcome the claim objection and rejections under 35 U.S.C. 112 and 35 U.S.C 101. The objection and rejections are hereby withdrawn.

### ***Final Rejection***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 8, 15, 24, and 33 recite the limitation "predetermined". This limitation lacks proper written description support in the specification.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Java 2: The Complete Reference” hereinafter referred to as Java in view of Henson (US 6,167,383).**

Referring to claims 1-4, 7, 8-11, 14-19, 24-28, 33-36, and 39, Java teaches a method comprising: providing a set of one or more customizable product classes (pages 132 and 133); receiving a request to designate a customizable product from the set of one or more customizable product classes as a customizable product instance, and designating a customizable product class from the set of one or more customizable product classes as the customizable product instance (page 134). Java teaches that the command “Box mybox = new Box( );” accepts a request to create a customizable product instance and creates an instance of the customizable product class. Java also teaches the steps of providing a set of one or more component products, the set of one or more component products associated with the customizable product instance, and receiving a request to associate a first component product from the set of one or more component products with the customizable product instance (pages 192 and 193). The Applicants’ specification teaches that component products are subclasses and inherit attributes from the customizable product class (see paragraph [0025]). Java also teaches subclasses and inheritance (pages 192 and 193). Java does not explicitly disclose the step of determining whether or not to associate the first or a second

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component product (i.e. subclass) with the customizable product instance. However, Java discloses that inheritance is a “cornerstone” of object-oriented programming because it allows the creation of hierarchal classifications of subclasses (page 192). Furthermore, Henson discloses a method and apparatus for configuring a product using “...programming techniques well known in the art.” (col. 5, lines 52-54) that determines whether to associate the first component product from the set of one or more component products with the customizable product instance based on a predetermined set of customizable class rules (col. 8, lines 56 – col. 9, line 8). The Applicants’ specification discloses that the step of determining whether to associate a component product with a customizable product instance based on customizable class rule allows for restricting or excluding one or more component products based on the selection of a specific component in order to guide the consumer to choose the appropriate products (paragraph [0028], lines 5-8; paragraph [0061], lines 1-8). Henson discloses a validation module that validates a customer configured system to ensure that it can be physically built (col. 8, lines 45-55) and disables (i.e. restricts) an option that cannot exist with a selected option (col. 8, lines 56 – col. 9, line 8). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Henson into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to ensure that a system could be physically built, as taught by Henson.

Referring to claims 5, 6, 12, 13, 20-23, 29-32, 37, and 38, Java does not explicitly disclose a theme UI, control UI, group UI, discount pricing information, or instructions on

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how to select a class. However, the Examiner notes that these limitations are not functionally involved in the steps or elements of the recited method and apparatus. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of receiving, designating, providing, and determining would be performed the same regardless of what user interface (UI) was provided. The differences between the content of the Applicants' invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any user interface in the invention of Java because such information does not functionally relate to the steps of the claimed method or apparatus and because the subjective interpretation of information does not patentably distinguish the claimed invention.

### ***Response to Arguments***

Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

December 13, 2005



**WYNN W. COGGINS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600